

REMARKS

Claims 1-31 are pending in the application. Claims 4, 5, 8, 9 and 18-30 have been withdrawn. Claims 1-3, 6, 7, 10-17 and 31 have been rejected by the Examiner. Claims 1 and 31 are currently amended.

Claim Rejections Under 35 U.S.C. § 102

Claims 1, 3, 6, 10 and 15 are rejected under 35 U.S.C. § 102(b) as being anticipated by Prather (U.S. Patent No. 5,404,887). This rejection is respectfully traversed.

The Office Action of August 25, 2008 states that Fig. 14 of Prather illustrates surface contours 78, and that these surface contours are as claimed in independent Claim 1 and associated dependent claims. Applicants respectfully disagrees with the Examiner's interpretation of Prather with regard to Fig. 14.

Indeed, Prather as a whole is directed to a guide wire having a sleeve member formed from an extruded polymer. The sleeve member has an unsmooth exterior surface, such that when the sleeve is disposed on a guide wire, the guide wire is thereby provided with a rough exterior surface.

Figure 14 of Prather is not a departure from this sleeve-with-a-rough-exterior approach. Fig. 14 is intended to illustrate generally how a guide wire having a sleeve with a rough exterior, as taught throughout the reference, behaves within the interior of a lumen. But there is nothing in the Prather reference to suggest that the exterior protrusions of the guide wire are not provided by a sleeve. To the contrary, the discussion of Fig. 14 specifically refers to a sleeve:

As can be clearly seen by comparing Figs. 13 and 14 the guide wire according to the present invention reduces the amount of surface area contact between the exterior of the

guide wire and the guide wire lumen wall. *In addition, the sleeve according to the invention may be extended over a greater length of the core wire than illustrated in the preferred embodiments.* In fact, the sleeve member could extend substantially the entire length of the core member if desired. (Prather, Col. 8, ll. 50-59)(emphasis added).

Claim 1 of the present invention is quite different from the disclosure of Prather. For example, Claim 1 recited “a section of the elongated core includes at least one of randomized and non-randomized tactile surface contours.” There is no “tactile surface contour” on a core in Prather. It is clear from the overall disclosure of Prather that only a sleeve having exterior roughness, and not a core with “tactile surface contours” on the core itself, as claimed, is shown in Prather.

Similarly, independent Claim 16 provides a polymer coating that follows “randomized surface contours of the exterior surface of the distal core section.” Again, there is no such disclosure in the Prather reference.

The Office Action of August 25, 2008, pg. 13, states that:

The language of the claim does not exclude the sleeve and core from being taken together to embody an elongated core. Alternatively, the sleeve itself could be construed as the elongated core.

Claim 1 herein is amended to refer to an "elongated wire core" which should alleviate the Examiner's concern. Non-limiting examples of a "wire core" appear in Fig. 11 as reference no. 98, and in Fig. 19 as reference no. 122.

Further, independent Claim 1 now claims a polymer coating as follows: "an uninterrupted polymer coating with a generally constant outside diameter adhering to at least a portion of the elongated wire core and having a surface contour that follows the at least one of randomized and non-randomized tactile surface contours in the elongated

wire core." The Prather reference does not disclose a polymer coating as claimed in Claim 1.

The independent claims are amended herein to emphasize that the surface contours are part of the surface of the wire core itself and not provided, for example, by a separate sleeve.

If the Examiner continues to feel that the Prather reference illustrates a wire core having contours that are integral to the surface itself and not provided by a sleeve, the undersigned respectfully asks the Examiner to cite the column number and line numbers in the specification where such a disclosure is made. The undersigned has reviewed the reference in detail, and finds no disclosure of contour on the surface of the guide wire itself, but only of contour provided by a separate sleeve.

Consequently, withdrawal of the §102(b) rejection of Claims 1, 3, 6, 10 and 15 is respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

Claims 2, 7 and 16-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Prather (U.S. Patent 5,404,887) as applied to Claim 1, and further in view of McMahon (U.S. Patent No. 6,296,616). Claim 11 is rejected under 35 U.S.C. 103(a) as unpatentable over Prather as applied to Claim 1, in further view of Mageoh (U.S. Patent 3,371,671). Claims 12 and 13 are rejected as being unpatentable over Prather as applied to Claim 1, and further in view of Richardson et al. (WO 01/036034). Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prather as applied to Claim 1, in view of Murayama et al. (US 2004/0039309). Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prather in view of McMahon (US Patent

6,296,616), Richardson et al. (WO 01/36034), and Murayama et al. (US 2004/0039309). These rejections are respectfully traversed.

Applicants respectfully disagree with the Examiner's interpretation of Fig. 14 of the Prather reference and the rejections based on that interpretation. Applicants contend that Prather consistently teaches use of a sleeve, and does not disclose "at least one of randomized and non-randomized tactile surface contours" on the elongated wire core, as now recited in Claim 1, and that the foregoing obviousness rejections are no longer appropriate. Withdrawal of the §103 rejections is therefore solicited.

Furthermore, with respect to independent Claim 16, the McMahan reference does not disclose that "an exterior surface of the distal core section includes randomized tactile surface contours," as provided in Claim 16. The exterior surface of the distal core section of McMahon is smooth and, as previously discussed, the distal core section of Prather is also smooth, with only a sleeve providing exterior roughness.

On this further ground, withdrawal of the §103 rejection with respect to independent Claim 16 and its dependent Claim 17 is also solicited.

Regarding Claim 31, this claim has been amended to recite "an elongated wire core having a proximal wire core section and a distal wire core section." As with amended Claim 1, this alleviates any concern that the core section can include, for example, a sleeve as in the Prather reference.

Double Patenting

Claims 1-3, 6-7 and 10-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1, 3, 6 and 9-13 of co-pending U.S. Application Serial No. 11/762,617. As this is a provisional rejection,

Applicants will delay a response on this issue until receiving indication of allowable subject matter in the present application.

Request for Continued Examination

The Office action of August 25, 2008 is a final rejection. The Advisory Action of October 31, 2008 indicates that the Applicant's amendments of October 21, 2008 have been entered into the record. Consequently the claim amendments in this filing do not repeat the amendments already made in Applicant's paper of October 21, 2008, but reflect only new amendments made herein.

A Request for Continued Examination (RCE) is hereby made, and the fee therefore is paid at the same time this paper is filed.

Conclusion

In view of the foregoing, Applicants respectfully submit that all claims are now in condition for allowance. Reexamination and reconsideration of the application are

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respectfully requested and allowance at an early date is solicited. Applicants invite the Examiner to telephone the undersigned if there are any remaining questions.

Respectfully submitted,

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